

REMARKS

Claims 18-22 remain pending in the present application. The Examiner is respectfully requested to reconsider and withdraw his rejections in view of the remarks as set forth below.

Applicant would like to thank the Examiner for the courtesies extended to applicant's representative during a telephone interview on January 23, 2004. During that interview, the Examiner stated that previously submitted declarations are defective in two ways.

First, the Examiner noted that the documentary evidence supporting the declarations does not show the step involving the purchasing intermediary as set forth in the Office Action mailed October 21, 2003. Arguments set forth below address this issue.

Second, the Examiner stated that the declarations did not adequately support a showing of due diligence. This issue was first raised by a previously assigned Examiner in an advisory action mailed on October 17, 2002. In particular, the Examiner asserted that there was inadequate time to consider this issue after final. Applicant subsequently filed a Request for Continued Examination for continue prosecution of this application. In a first Office Action mailed February 10, 2003, the Examiner stated that the declarations were insufficient for failing to show the step involving the purchasing intermediary. The Office Action did not address the issue of due diligence, and thus Applicant assumed that this aspect of the declarations were sufficient. Likewise, the

currently outstanding Office Action did not address the issue of due diligence. Thus, no rejection of the declarations on this basis can be found in the record. If the newly assigned Examiner wishes to raise this issue, Applicant requests that a formal rejection be issued specifically identifying the deficiency in the declarations. Moreover, Applicant requests that the final rejection be withdrawn in the present application, thereby giving Applicants a proper opportunity to respond.

REJECTIONS UNDER 35 USC §103

Claims 18-21 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,145,741 (Wisdom). Applicant respectfully traverses this rejection.

It is believed that the pending claims are patentably distinct over Wisdom. However, in order to expedite prosecution, Applicant previously submitted a declaration in accordance with 37 C.F.R. §1.131 which establishes the conception of the Applicant's invention in the United States prior to April 27, 1999, which is the filing date of the Wisdom reference. The Examiner states that the declarations filed in a parent application are not automatically made part of the record. Applicant notes that revised declarations were submitted for consideration with Applicant's response dated July 10, 2003 and thus constitutes the declarations at issue in the present application. Copies of the revised declarations are attached hereto.

Next, the Examiner asserts that the evidence submitted is insufficient to establish the conception of the invention prior to the effective date of the Wisdom

reference. Specifically, the Examiner asserts that the documentary evidence does not show the step involving the purchasing intermediary. Applicant respectfully disagrees.

First, Applicant asserts that the documentary evidence does show that the purchasing cards would be provided by a purchasing intermediary to a retail establishment for distribution to consumers. To evidence conception, Applicant submitted a mock up of an exemplary purchase card. PRIVACASH.COM serves as the purchasing intermediary who sits between the issuing bank, noted as Key Bank on the mock-up card, and the purchaser. The mock-up card further provides various instructions as to how to use the card. For instance, the card states "Just go to our website at PRIVACASH.COM and type in the number below ... [y]our card is immediately activated." Since the purchaser is required to activate the card by contacting the purchasing intermediary, this implies that the card was acquired from someone other than the purchasing intermediary. In other words, the purchase card must have been supplied from the purchasing intermediary to a retail establishment, where the card was purchased by the purchaser. Thus, the documentary evidence shows the step involving the purchasing intermediary.

Alternatively, Applicant notes that the Examiner must consider all of the evidence presented in its entirety, including the declaration. MPEP 715.07. Furthermore, an accompanying exhibit need not support all claimed limitations, provided that any missing limitations are supported by the declaration. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). Thus, Applicant has revised the declarations made by the inventors to further corroborate this feature of

the claimed invention. In particular, the declarations state "[t]o the extent that the attached document does not disclose the step involving the purchasing intermediary, I further declare that prior to April 27, 1999, the inventors had conceived, in the United States, that the purchasing cards in the Subject Application would be provided by a purchasing intermediary to a retail establishment for distribution to consumers" (see paragraph four). Since an accompanying exhibit need not support all claimed limitations, provided that any missing limitations are supported by the declaration, Applicant asserts that the revised declarations are sufficient to overcome the outstanding rejection.

In sum, Applicant asserts that the rejection has been overcome by the submission of the declarations. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

CONCLUSION

All of the stated grounds for rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and further requests that they be withdrawn. Accordingly, it is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at (248) 641-1230.

Prompt and favorable consideration of this response is respectfully
requested.

Respectfully submitted,

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